

REMARKS

Claims 1-23 are pending in the application.

Claims 1-23 are rejected.

Reconsideration and allowance of claims 1-23 is respectfully requested in view of the following:

Responses to Rejections to Claims – 35 U.S.C. §103

Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howell et al (U.S. Patent No. 5,825,616) (Howell) in view of Viletto (U.S. Patent No. 5,475,626) (Viletto) and further in view of Hosoi et al (U.S. Patent No. 5,210,681) (Hosoi). These rejections are not applicable to the amended claims.

This invention claims a battery housing including a plurality of cells, some of which are removed to create a space for a speaker. A speaker container is inserted into the space in the battery housing created by removal of some of the cells. The speaker container includes a latch which engages a slot in the battery housing. As a result, the battery housing contains batteries and a speaker, without changing the dimensions of the battery housing.

Claim 1 includes: preparing a selective portion of the battery housing including a slot formed therein, the selective portion being prepared to receive the speaker container by removal of less than all of the cells from the plurality of cells to create a space in the housing for a speaker; and receiving the speaker container in the created space, the speaker container including a latch to be placed in the slot of the selective portion of the battery housing, wherein dimensions of the battery housing having the speaker container are substantially unchanged and the speaker container is secured by the latch, whereby the battery housing houses batteries, the speaker container and a speaker.

As the PTO recognizes in MPEP §2142:

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons:

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained...if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the references, alone, or in any combination, do not teach preparing a selective portion of the battery housing including a slot formed therein, the selective portion being prepared to receive the speaker container by removal of less than all of the cells from the plurality of cells to create a space in the housing for a speaker; and receiving the speaker container in the created space, the speaker container including a latch to be placed in the slot of the selective portion of the battery housing, wherein dimensions of the battery housing having the speaker container are substantially unchanged and the speaker container is secured by the latch, whereby the battery housing houses batteries, the speaker container and a speaker.

Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the references cannot be combined and applied to reject the claims under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Recently, the Supreme Court ruled that the "teaching, suggestion, or motivation (TSM) test" for determining obviousness still applies, but should be used in a more "expansive and flexible" manner. *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. ___, 11 (2007). The Court stated that

"a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *Id.* at 14-15, emphasis added.

None of the references relied on teach or suggest the claimed invention whether considered singly or in any combination.

Howell teaches an apparatus for locking and ejecting a media module but does not teach or suggest a speaker housing latched into a space created in a battery housing by removal of some, but not all, of the batteries.

Viletto adds nothing to teach or suggest the claimed invention. The battery pack 87 of Viletto is inserted into a completely vacant housing 252 to provide a rechargeable battery source for a portable computer.

Hosoi adds a battery pack which changes (increases) the overall dimensions of the battery housing.

Therefore, there is no single or combined teaching which obviates the claimed invention and reconsideration is respectfully requested.

Thus, in the present case it is clear that the USPTO's combination arises solely from hindsight based on the present disclosure without any reason why a person of ordinary skill in the art would combine the references as required by the claims. Therefore, for this mutually exclusive reason, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and the rejection under 35 U.S.C. §103(a) is not applicable.

Therefore, independent claims 1, 11, 21 and 23 and their respective dependent claims are submitted to be allowable.

In view of all of the above, the allowance of claims 1-23 is respectfully requested.

The amended claims are supported by the original application.

PATENT

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The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



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